

Serial No. 10/588,805

Art Unit: 3612
Examiner: Jason S. Morrow**REMARKS**

In response to the Patent Office Action of November 18, 2009, the Applicant respectfully requests reexamination and reconsideration. To further the prosecution of this application, additional amendments have been made in the claims and with these amendments, all claims in this application should now be in condition for allowance.

On page 2 of the Patent Office Action in paragraph 1, the Examiner has objected to the drawings as not illustrating the features specified in the claims. The claims have been accordingly amended so that it is not believed that any further drawings are required. Specific reference to "motorized" has been deleted from claims 4, 5, 23 and 24.

On page 3 of the Patent Office Action, the Examiner has presented a rejection of all pending claims under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. On pages 4 and 5 of the Patent Office Action, the Examiner has responded to previous arguments made by the Applicant.

In paragraph 3 of the Patent Office Action, the Examiner has raised basically two issues. First, the Examiner has stated that there must be "some way of holding the lid in the raised position to support a user's calves." Secondly, the Examiner has raised the question as to the positioning of the motors. With respect to both of these issues, the Applicant has previously filed of record photographs showing a completed commercial product.

The enablement requirement refers to the requirement set forth in 35 U.S.C. §112, first paragraph, wherein the specification, claims and drawings are sufficient to describe the manner in which to use the claimed invention. The information contained in the total disclosure of the application, including the specification, claims and drawings is to be sufficient to inform one skilled in the relevant art how to both make and use the claimed invention.

An analysis of whether a particular claim is supported by the disclosure in a patent application requires a determination of whether that disclosure contains sufficient information regarding the subject matter of the claims so as to enable one skilled in the pertinent art to make

Serial No. 10/588,805

Art Unit: 3612
Examiner: Jason S. Morrow

and use the claimed invention. The standard for determining whether the specification meets the enablement requirement is set forth in, for example, *In re Wands*, 858 F.2d 731, 737; 8 USPQ 2d 1400, 1404 (Fed. Cir. 1988). Thus, it has been interpreted that the claimed invention, to be enabled, requires that a person skilled in the art can make and use the invention "without undue experimentation." The test for enablement is thus whether one skilled in the art could make or use the invention from the disclosures in the patent application coupled with information known in the art and without undue experimentation.

With regard to undue experimentation factors, *In re Wands*, supra, has set forth certain factors that may be important in making this determination. These factors include: A) the breadth of the claims; B) the nature of the invention; C) the state of the prior art; D) the level of one of ordinary skill; E) the level of predictability in the art; F) the amount of direction provided by the inventor; G) the existence of working examples; and H) the quantity of experimentation needed to make or use the invention based on the content of the disclosure.

The determination of the propriety of a rejection that is based upon the scope of a claim relative to the scope of the enablement, involves basically a two-stage inquiry. The first is to determine how broad the claim is with respect to the disclosure. The second inquiry is to determine if one skilled in the art is enabled to make and use the entire scope of the claimed invention without undue experimentation. Taking into consideration the teachings in the present application, along with the knowledge of one skilled in the art, in the present instance, there is clearly no need for undue experimentation in order to provide an enablement of the present invention.

In connection with the rejection set forth by the Examiner, the Examiner has first questioned the way that the lid is held in a position for support of the calves of the user. Secondly, the Examiner has raised the issue relating to the motors and how they are arranged or positioned to maintain the least amount of intrusion into the storage space. With respect to both of these issues, the Applicant has previously enclosed copies of photographs illustrating an actual

Serial No. 10/588,805

Art Unit: 3612
Examiner: Jason S. Morrow

rest configuration. The purpose of submitting these photographs was to show that no undue experimentation was necessary in having one skilled in the art construct an actual device with the teachings of the present application along with the knowledge of one skilled in the art.

As has been pointed out previously, motor controls for vehicle seats can be easily adapted for control of a lid in a rest. In this regard reference has been made previously to U.S. Patent No. 4,366,983 and the teaching of a drive motor and worm gear system for selective adjustment of the inclination of a seat. In this connection, in the recent Patent Office Action, the Examiner has indicated that by viewing the submitted photographs "it is easy to see how the principles of the drive mechanism shown in U.S. Patent No. 4,366,983 can be applied to the current invention." It is the Applicant's position that one skilled in the art does not need to see these photographs in order to conclude that the principles of the '983 patent can indeed be used in controlling the lid construction of the present invention and that this can be accomplished without undue experimentation.

The present application should be considered in total including the original specification, claims and drawings. The original specification clearly indicates that the "lid may be powered." The specification also indicates that the lid is pivotal and may be moved between opened and closed positions. A closed position is shown, for example, in Figs. 1 and 6 and an open position is illustrated in Figs. 2 and 7. In a purely non-motorized version of the present invention, it would be quite apparent to one skilled in the art that some type of a stop may be used, particularly to hold the lid in an open position. This would not require any undue experimentation by one skilled in the art. In the closed position such as illustrated in Fig. 1, the lid would simply rest upon the base. In the open position, a stop or interlocking detent would be used to hold the lid in an open position. Certainly, this is well within the purview of one skilled in the art and does not require any undue experimentation.

Moreover, and with particular reference to Fig. 2 of the drawings of this application, it would be apparent to one skilled in the art that a type of rack and pinion, usable with regard to

Serial No. 10/588,805

Art Unit: 3612
Examiner: Jason S. Morrow

the base, can also be applied to the lid. The rack and pinion arrangement enables the mechanism to be held in any particular position as determined by the rotation of the pinion.

With respect to the rack 10 and pinion 11 associated with the rails 9, in the present specification, it is taught that the foot rest, such as shown in Fig. 4, can be moved in the direction of arrow 26. The position of the foot rest is taught as possibly being altered to suit by the passenger in the direction shown by the arrow 26. Thus, it is quite apparent to one skilled in the art that with the use of a button or the like (see U.S. Patent No. 6,527,327 at column 2, line 31) one can selectively control the position of the lid to be in a number of different open positions such as the positions illustrated in Figs. 2 and 7 in the present drawings.

Furthermore, and with reference to Fig. 2 of the present application, it is noted that the pivot 6 is also illustrated similarly to the pinion 11 and that the base support for the lid is also in the form of a rack-type surface illustrated by a sawtooth line on the base member of the lid. This illustration in Fig. 2 along with the description in the present specification, along with the normal knowledge of one skilled in the art, would clearly indicate that the lid can also be driven in the direction of arrow 7 in Fig. 2 in multiple positions with an arrangement substantially the same as the rack and pinion used for the base of the rest.

The Examiner has also stated in connection with his rejection that "Applicant claims at least two motors, the positioning of which, size, type, and arrangement of which is not disclosed." First, motors are no longer specifically claimed. Second, the Applicant is not claiming any particular size of storage compartment. Theoretically, the storage compartment in accordance with the present invention could be storing small items such as a pen. Furthermore, there is nothing presently being claimed that is specific to any size of the storage compartment, only the fact that there is a storage compartment.

Moreover, the consideration of where motors can be located is well within the knowledge of one skilled in the art and does not require any undue experimentation. For example, in U.S. Patent No. 4,366,983, a motor arrangement is provided at the pivot area of the seat. The location

Serial No. 10/588,805

Art Unit: 3612
Examiner: Jason S. Morrow

of motors is well within the skill of one in the art and does not require any undue experimentation. One skilled in this particular art should be aware of many different mechanisms for driving seat mechanisms that can be used with the lid mechanism of the present invention. This includes not only motor arrangements but also other types of mechanical coupling structures that coupled from a motor to other mechanisms. The state of the art in connection with this particular invention is basically old and well developed. What level of experimentation would be required to place motors and yet leave some room for a storage compartment? The answer to that question is that the particular decision would be well within the purview of one skilled in the art and not require any undue experimentation.

On page 4 of the Patent Office Letter, the Examiner has also made further comments. His first comment relates to the manner in which the mechanism is arranged and packaged. The Applicant believes this position is in error in that the claims are not at all directed to an arrangement or packaging. The Examiner has also taken the position that the structure of a vehicle seat is so different than that of the lid that this requires substantial thought and planning. Again, particularly when taking Fig. 2 of the present application into account, there is little or no planning that is required in order for one skilled in the art to know how to control the lid between open and closed positions whether it be by motorized mechanism or not. Again, this can be accomplished in accordance with the present invention and the teachings without undue experimentation.

CONCLUSION

In view of the foregoing amendments and remarks, the Applicants respectfully submit that all of the claims pending in the above-identified application are in condition for allowance, and a notice to that effect is earnestly solicited.

If the present application is found by the Examiner not to be in condition for allowance, then the Applicants hereby request a telephone or personal interview to facilitate the resolution of

Serial No. 10/588,805

Art Unit: 3612
Examiner: Jason S. Morrow

any remaining matters. Applicants' attorney may be contacted by telephone at the number indicated below to schedule such an interview.

The U.S. Patent and Trademark Office is authorized to charge any fees incurred as a result of the filing hereof to our Deposit Account No. 19-0120.

Respectfully submitted,
George Bowen, Applicant

Dated: 3-1-10By: 

David M. Driscoll, Reg. No. 25,075
Applicant's Attorney
SALTER & MICHAELSON
321 South Main Street
Providence, Rhode Island 02903
Telephone: 401/421-3141
Facsimile : 401/861-1953
Customer No. 000987

E:\Wilson\Gunn\02867 Bowen\response to 11 18 09 OA.wpd